

REMARKS

Applicant has carefully reviewed the Application in light of the Advisory Action mailed January 28, 2005. At the time of the Office Action, Claims 1-3, 5-16, and 18-22 were pending in the Application. Applicant respectfully disagrees with the Examiner's statement that the proposed amendments "raise new issues." However, for purposes of expediting the prosecution of this case, Applicant provides the following Request for Continued Examination (RCE) in order to address the Examiner's concern.

Applicant reiterates the previously-proposed amendments of Claims 1, 8, 14, and 21. It is important to note that the amendments are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues, only further clarify subject matter already present, and have been made only to advance the prosecution of this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1, 4-8, 10-14, and 17-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,845,077 issued to Fawcett (hereinafter "*Fawcett*"). This rejection is respectfully traversed for the following reasons.

Fawcett cannot properly support a §102 rejection because it fails to teach, suggest, or disclose each and every limitation of Independent Claim 1. For example, Independent Claims 1, 8, 14, and 21 recite, in general, the ability to execute a comparison that includes: loading the communication device with the first software; determining the first variable set; loading the communication device with the second software; determining the second variable set; and comparing the first variable set to the second variable set to identify the changed variables.

Fawcett discloses a service update application on the update service computer that compares the inventory data collected from the user computer to data stored in a database on the update service computer. (See Abstract of *Fawcett*.) But *Fawcett* fails to offer any ability to load software into a target computer for purposes of verifying software. Indeed, *Fawcett* fails to offer any such teaching and, therefore, cannot possibly inhibit the patentability of the pending claims.

For this teaching, the Examiner generically cites Column 7, lines 23-56 from *Fawcett*. However, evaluating this passage closely reveals that the above-identified limitation is simply not found therein. *Fawcett* explicitly provides: “When the user update application attempts to make the desired connection (60), the update service computer launches a service update application (64). A two-way communications path (66) is set up between the service update application on the update service computer and the user update application on the user computer. The service update application on the update service computer then requests that the user update application on the user computer conduct an automatic inventory of all computer software installed (68) on the user computer.

In the illustrated system, this inventory is done automatically (i.e. without input from the user), and is completed by assigning the inventory task to a Windows 95 operating system process thread on the user computer. The operating system thread completes the task in the “background” while the user is performing other activities in the “foreground” (e.g. choosing options from the user update application)...During the inventory, data is collected about all computer software installed on the user computer. Data such as the software title, date, version, file size, file checksum, directory location on the user computer, etc. are collected. After the inventory is complete, the user update application sends (70) the inventory data from the user computer to the service update application on the update service computer. The service update application compares the user inventory data from the user computer to database entries in the computer software database to automatically analyze the computer software stored on the user computer (72).” (See Columns 6-7, lines 65-33.)

Hence, taking a software “inventory” in such a fashion is not akin to “loading” software into any device for purposes of verification. *Fawcett* mentions downloading software into a given device, but only in the context of providing a subsequent software upgrade (or a copy of the software that functions optimally, as opposed to software that may be running on an end user computer and experiencing a problem). Such downloading in *Fawcett* is done after a determination is made as to what resides in the target/end user computer and (potentially) what is functioning properly in the target computer. For at least this clear distinction, the Independent Claims are allowable over *Fawcett*. Notice to this effect is respectfully requested in the form of an allowance of these claims.

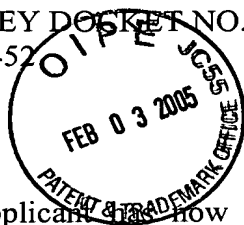
Section 103 Rejection

The Examiner rejects Claims 2, 9, 15, and 22 under 35 U.S.C. §103(a) as being unpatentable over *Fawcett* in view of U.S. Patent No. 6,694,335 issued to Hopmann, et al. (hereinafter "*Hopmann*"). The Examiner rejects Claims 3 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Fawcett* in view of U.S. Patent No. 6,381,741 issued to Shaw (hereinafter "*Shaw*"). These rejections are now moot in light of the §102 analysis provided supra. This is because in order to support a proper §103 rejection, the references, either standing alone or combined, must teach, suggest, or disclose all of the claim limitations. (See M.P.E.P. §2143.) Neither *Hopmann* nor *Shaw* are combinable with *Fawcett* in order to teach each and every limitation of any of the pending Independent Claims. None of these additional references teach the identified claim element of Independent Claims 1, 8, 14, and 21 that was lacking from *Fawcett*. Accordingly, all of the claims are allowable over the cited references. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas Frame at (214) 953-6675.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant

A handwritten signature in cursive script that reads "Thomas Frame".

Thomas Frame
Reg. No. 47,232

Date: February 3rd, 2005

CORRESPONDENCE ADDRESS:

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